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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/738,954      | 12/15/2000  | Benjamin F. Cravatt  | SCRIP1210-2         | 1708             |

7590

08/20/2002

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EXAMINER

TRAN, MY CHAU T

ART UNIT

PAPER NUMBER

1641

DATE MAILED: 08/20/2002 13

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/738,954

Applicant(s)

CRAVATT ET AL.

Examiner

My-Chau T. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 April 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is nonfinal.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-52 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered new claims 27-47 have been renumbered 32-52.

2. Applicant's amendment filed April 30, 2002 in Paper No. 12 is acknowledged. New Claims 27-47 are renumbered to be Claims 32-52 as stated above. Claims 1-52 are pending.

### ***Election/Restrictions***

3. Regrouping of the pending claims has been necessitated by the amendment of April 30, 2002 and added new claims. The restriction requirement of record is modified as set forth below

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-7, drawn to a method for screening for bioactivity of a candidate compound toward a group of related target proteins, classified in class 424, subclass 9.1.

II. Claims 8-10, drawn to a method for screening for bioactivity of a candidate compound toward a group of related target enzymes, classified in class 424, subclass 94.1.

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- III. Claims 11-16; *19-26; 41; 47-52; (part of each) 38-40, 42-46*, drawn to a method for determining the presence of active target members of a group of related proteins, classified in class 435, subclass 7.8.
  - IV. Claims 17; *(part of each) 32-40, 42-46*, drawn to a method for determining in a plurality of proteomic mixtures the presence of active target members of a group of related proteins, classified in class 436, subclass 161.
  - V. Claim 27, drawn to a system for identifying active target proteins, classified in class 702, subclass 19.
  - VI. Claims 28-31, drawn to a system for determining the status of a biological system, classified in class 702, subclass 81.
  - VII. Claims *18; (part of each) 32-40, 42-46*, drawn to a method for determining in a plurality of proteomic mixtures the presence of active target members, classified in class 435, subclass 4.
5. The reasons for restriction are of record in the office action of December 19, 2001.
6. Previously Claim 18 was grouped with Claim 17. It is now separated from Claim 17 because it has been amended such that the method steps of Claim 18 are different from those of Claim 17.

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7. In view of the fact that claim 19 has been amended to effectively be a subset of Claim 11 (i.e. “enzymes” are a subset of “proteins”), Claim 19 has been included with the invention of Claim 11 (Group III).

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to My-Chau T. Tran whose telephone number is 703-305-6999. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Long V. Le can be reached on 703-305-3399. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-872-9307 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

mct  
August 8, 2002

*Mary E. Ceperley*  
MARY E. CEPERLEY  
PRIMARY EXAMINER  
AU 1641